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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,774	12/12/2003	Hidetoshi Okawa	1226-104	8752
23117	7590	05/16/2005	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 05/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,774

Applicant(s)

OKAWA, HIDETOSHI

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 504.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a stretched product, classified in class 428, subclass 364.
- II. Claims 9-19, drawn to a process for producing a stretched article, classified in class 264, subclass 211.22.

The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as a process of producing a plate or disk.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

During a telephone conversation with Bryan Davidson on 5-11-05 a provisional election was made with traverse to prosecute the invention of Group I, claims 9-19. Affirmation of this election must be made by applicant in replying to this Office action.

Art Unit: 1711

Claims 1-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12, 18 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aoshima et al. (US 4,668,761).

Aoshima discloses a process in which a tube having a diameter of 4mm outer and 1mm inner is made by extrusion and stretching at temperatures up to the softening point of an "acetal copolymer" made by Polyplastic having the tradename DURACON M25-04. See Examples 1-12 in column 15. Note that the polyacetal copolymers have applicants comonomer units "1" at column 11, lines 9-14 including branching units such as pentaerythritol derived units. Note that the MFI is 1-20 at column 11, lines 16-18 and 90-99% of oxymethylene recurring units are present at column 11, lines 20-25.

It appears that the above material DURACON M25-04 is produced by Applicants Company. If applicants are aware of any publicly available information regarding the specifics of this material (or any other trade named POM copolymer) such as MI or molecular weight or specific composition they should submit such information in keeping with their duty of disclosure.

Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoshima, cited above.

Aoshima does not disclose that the materials of the examples have all of applicant's characteristics and comonomer content, although patentee's specification does disclose such. Hence to use applicants specific POM in the process of forming a product in Aoshima's process would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention, in the expectation of adequate result absent any showing of surprising or unexpected results.

Claims 9-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Kikutani (WO 03/025268).

Kikutani disclose a process of forming a fiber by melt spinning POM from a 6mm nozzle and stretching while heating. Note the examples as well as Table 2 for applicants comonomer unite in applicants amount in a POM having MI of 9.

It is noted that US 6,818,294 corresponds to the above WO patent and is therefore presumably identical but is of course in English.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

Art Unit: 1711

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,818,294. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of the patent overlaps in scope with the instant claims and includes applicants various limitations.

Claims 9-19 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-19 of copending Application No. 10/308,040. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of stretching and heating applicants specific polymer is disclosed by the examples of the specification of the copending application and as such examples are required to support the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1711

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis
at telephone number 571 272 1075.

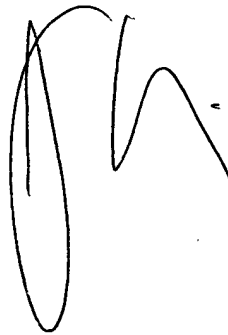
Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

5-11-05

Jeffrey Mullis
Primary Examiner
Art Unit 1711

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a series of loops and a final upward stroke.